

REMARKS

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

In the specification, Paragraph [0036] has been amended on page 10.

Claims 51, 55-57 and 87 have been cancelled without prejudice to further prosecution on the merits.

Claims 1, 10-11, 19, 42, 45, 75, 83 and 86 have been amended.

This amendment adds, changes and/or deletes claims in this Application. A detailed listing of claims that are, or were, in the Application, irrespective of whether the claim(s) remain under examination in the Application, is presented, with an appropriate defined status identifier.

Claims 1-50, 52-54, 58-86 and 88 are now pending.

The Applicants believe that the present Application is now in condition for allowance. Favorable reconsideration of the Application as amended is respectfully requested.

Interview Summary – Statement of Substance

The Applicants would like to thank the Examiner for the courtesy extended during the telephone Interview which took place on March 29, 2004.

The Applicants' representatives and the Examiner discussed the Office Action dated January 27, 2004, including the references cited by the Examiner as they relate to the currently pending claims. Amendments to the claims were discussed as they relate to various rejections made in the Office Action, along with those made for reasons of clarity. The following points were discussed:

- Applicants indicated an intent to withdraw certain matter as described herein.
- The Examiner and the Applicants agreed that Okojima '604 fails to teach any type of damping means. The Applicants proposed amending the independent claims to include a damping means (or the like).

- The Applicants indicated an intent to challenge the combination of Okojima '604 in view of Leung '085 under 35 U.S.C. § 103(a) according to the arguments described herein.
- The Applicants described that an advantage of placing the damped hinge structure on a cosmetic case is to prevent rapid opening of the lid. The Examiner indicated that such “limitations” are “intended use and could not be the sole determination of patentability.” The Applicants believe that such an advantage should be considered in combination with all other advantages and limitations when determining patentability. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). Further, intended use recitations and other types of functional language cannot be entirely disregarded. See M.P.E.P. § 2111.02. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989).

Drawings

In Section 3 of the Office Action, the Office stated that the “addition of element (13) and figures 8a and 8b comprise new matter.” FIGURES 8A and 8B have been deleted from the Application. The Applicants respectfully request acceptance of the amended Drawings.

Claim Rejections – 35 U.S.C. § 112 ¶ 2

In Section 3 of the Office Action, the Office rejected Claims 51, 55-57 and 87 under 35 U.S.C. § 112 ¶ 1 for failing to comply with the written description requirement. The Office stated that:

The addition of element (13) and figures 8a and 8b comprise new matter, for containing subject matter not described in the specification at the filing date. Examiner notes the original disclosure merely disclosed a “three-tiered configuration for wet-dry applications.” This functional language clearly does not sufficiently describe the structure platform (13) as described in figs. 8a and 8b.

Claims 51, 55-57 and 87 have been cancelled without prejudice to further prosecution on the merits, but the Applicants reserve the right to further prosecute these claims in

other applications. The Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112 ¶ 2 of Claims 51, 55-57 and 87.

Claim Rejections – 35 U.S.C. § 102

In section 5 of the Office Action, the Office rejected Claims 1-5, 42-44, 48-50, 52, 75-79, 83-85 and 88 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,799,604 titled “Vanity Case” to Okojima (“Okojima ‘604”).

The Office stated that:

Okojima ‘604 discloses a vanity case, comprising a hinge assembly (14) coupling a cover (12) to a base (10), where the base and cover are provided as separate pieces, and having a tray (16) for containing a cosmetic material (see col. 3, lines 34-35, wherein it is disclosed the tray holds a cosmetic) and having a spring (62), serving to conceal the cosmetic in a closed position, and reveal the cosmetic in an open position when the latch means is unlocked.

In col. 4, lines 21-26, it is disclosed one end of the coil spring abuts a hinge block of the cover, and the other end abuts an inner wall of the receptacle, and the spring urges the cover to the open position shown in fig. 1.

Okojima ‘604 is directed to a “Vanity Case” including a “coil spring 62 is attached around the hinge pin 14 in such a manner that its one end abuts against a hinge block 64 of the cover 12 and its other end against an inner wall defining a hinge recess 66 of the receptacle 10.” (see Okojima ‘604 at col. 4, lines 21-26; and Figures 1, 5 and 10). Okojima ‘604 does not include a damper or damper assembly.

Amended Claim 1 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly coupled to the hinge assembly.” Claims 2-5 depend from independent Claim 1.

Amended Claim 42 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “hinge device comprising a biasing device and a damper.” Claims 43-44, 48-50 and 52 depend from independent Claim 42.

Amended Claim 75 is in independent form and recites a “cosmetic container” comprising, in combination with other elements, a “hinge assembly comprising a spring and a damper.” Claims 76-79 depend from independent Claim 75.

Amended Claim 83 is in independent form and recites a “cosmetic container” comprising, in combination with other elements, a “hinge assembly comprising a biasing means and a damper.” Claims 84-85 and 88 depend from independent Claim 83.

Okojima ‘604 does not identically disclose a “container for holding a cosmetic” comprising, among other elements, a “damper assembly coupled to the hinge assembly” or a “hinge device comprising a biasing device and a damper” as recited in independent Claims 1 and 42 or a “cosmetic container” comprising, among other elements, a “hinge assembly comprising a spring and a damper” or a “hinge assembly comprising a biasing means and a damper” as recited in independent Claims 75 and 83. The rejection of Claims 1, 42, 75 and 83 over Okojima ‘604 is improper. Claims 1, 42, 75 and 83 are patentable over Okojima ‘604.

Dependent Claims 2-5, which depend from independent Claim 1, dependent Claims 43-44, 48-50 and 52, which depend from independent Claim 42, dependent Claims 76-79, which depend from independent Claim 75, and dependent Claims 84-85 and 88, which depend from independent Claim 83, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 1-5, 42-44, 48-50, 52, 75-79, 83-85, and 88 under 35 U.S.C. § 102(b).

Claim Rejections – 35 U.S.C. § 103(a)

Claims 8 and 82

In section 7 of the Office Action the Office rejected Claims 8 and 82 as being obvious over U.S. Patent No. 4,799,604 titled “Vanity Case” to Okojima (“Okojima ‘604”) under 35 U.S.C. § 103(a).

Claim 1 (as amended) is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly coupled to the hinge assembly.” Claim 8 depends from independent Claim 1.

Claim 75 (as amended) is in independent form and recites a “cosmetic container” comprising, in combination with other elements, a “hinge assembly comprising a spring and a damper.” Claim 82 depends from independent Claim 75.

The “container for holding a cosmetic” recited in independent Claim 1 (as amended) and the “cosmetic container” recited in independent Claim 75 (as amended) would not have been obvious in view of Okojima ‘604, alone or in any proper combination under 35 U.S.C. § 103(a). Okojima ‘604 alone or in any proper combination does not disclose, teach or suggest a “container for holding a cosmetic” comprising, in combination with other elements, “a damper assembly coupled to the hinge assembly” or a “cosmetic container” comprising, in combination with other elements, “a hinge assembly comprising a spring and a damper.” To transform the “vanity case” of Okojima ‘604 into a “container for holding a cosmetic” (as recited in Claim 1) or a “cosmetic container” (as recited in Claim 75) would require still further modification, and such modification is taught only by the Applicants’ own disclosure.

The “container for holding a cosmetic” recited in Claim 1 and the “cosmetic container” recited in Claim 75, considered as a whole, would not have been obvious in view of Okojima ‘604. Claims 1 and 75 are patentable over Okojima ‘604. Dependent Claims 8 and 82, which depend from independent Claims 1 and 75, respectfully, are also patentable. See 35 U.S.C. §§ 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 8 and 82 under 35 U.S.C. § 103(a).

Claims 19-22, 37-41, 45-47, 53-54, 58-65 and 86

In section 8 of the Office Action the Office rejected Claims 19-22, 37-41, 45-47, 53-54, 58-65 and 86 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,799,604 titled “Vanity Case” to Okojima (“Okojima ‘604”) in view of U.S. Patent No. 6,178,085 titled “Calculator Lid Mechanism” to Leung (“Leung ‘085”).

The Office acknowledged that Okojima ‘604 does not disclose a “damping means limiting the pivot rate of the cover about the hinge” (emphasis added).

The Office stated that:

[Leung '085] discloses a lid mechanism comprising a hinge, a coil spring (62) encapsulated in a cartridge (38), a plug (70), and a viscous damping grease (84). Frictional engagement between the plug and the cover allows the lid to be opened in a controlled, damped manner.

It is further disclosed, in col. 5, lines 49-53, that the damping mechanism serves to, "slow down and counteract any tendency for rapid pivoting movement of the lid structure which would cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof." Although explicitly disclosed for preventing damage to electronics, one having ordinary skill would immediately recognize that the mechanism could be applied to any container wherein a rapid opening movement would be detrimental.

The Office concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hinge structure of the vanity case of [Okojima '604], providing the lid block (64) with a tubular portion/cartridge (38), coil spring (62), plug (70), and viscous damping grease (84) taught by [Leung '085], motivated by the benefit of a slow, controlled, damped opening of the lid to prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

The Office further acknowledged that:

Regarding the claimed limitations of the pivoting rate of the cover to between 60 and 120 degrees per second, [Leung '085] does not disclose the rate at which the cover will pivot.

However, the Office concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the damping mechanism to open the cover to between 60 and 120 degrees per second, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claim 19 is in independent form and recites a "container for holding a cosmetic" comprising, in combination with other elements, "a damper assembly coupled to the hinge assembly." Claims 20-22 depend from independent Claim 19.

Claim 37 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper means for limiting pivoting of the first platform at a rate of about 60 to 120 degrees per second.” Claims 38-41 depend from independent Claim 37.

Claims 45-47 and 53-54 are in dependent form and depend from independent Claim 42. Accordingly, dependent Claims 45-47 and 53-54 incorporate by reference all of the limitations of independent Claim 42. Independent Claim 42 recites a “container for holding a cosmetic” comprising, in combination with other elements, a “hinge assembly comprising a biasing device and a damper.”

Claim 58 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper means for limiting pivoting of the first platform to the use position.” Claims 59-65 depend from independent Claim 58.

Claim 86 is in dependent form and depends from independent Claim 83. Accordingly, dependent Claim 86 incorporates by reference all of the limitations of independent Claim 83. Independent Claim 83 recites a “cosmetic container” comprising, in combination with other elements, a “hinge assembly comprising a biasing means and a damper.”

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As understood by the courts, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). “The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Id.*

Okojima ‘604 alone or in any proper combination with Leung ‘085 does not disclose, teach or suggest a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly” (Claim 19), a “damper means” (Claims 37 and 58), or a “damper” (Claim 42), nor a “cosmetic container” comprising, in combination with other elements, a “damper” (Claim 83). To transform the “vanity case” of Okojima ‘604 and the “calculator lid mechanism” of Leung ‘085 into a “container for holding a cosmetic” (as recited in

Claims 19, 37, 42, and 58) or a “cosmetic container” (as recited in Claim 83) would require still further modification, and such modification is taught only by the Applicants’ own disclosure. The suggestion to make the combination of Okojima ‘604 and Leung ‘085 has been taken from the Applicants’ own specification (using hindsight), which is improper.

As acknowledged by the Office in Section 8 of the Office Action, “[Okojima ‘604] does not disclose a damping means limiting the pivot rate of the cover about the hinge.” Leung ‘085 does not provide any motivation or suggestion to modify the “vanity case” of Okojima ‘604 to provide any type of damper, damper means, or damper assembly. As the Office describes, “the damping mechanism [of Leung ‘085] serves to, ‘slow down and counteract any tendency for rapid pivoting movement of the lid structure which would cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof.’” The Office acknowledges that the damper mechanism of Leung ‘085 is “explicitly disclosed for preventing damage to electronics.” Thus, there is no motivation, suggestion, or teaching in Leung ‘085 to modify the “vanity case” of Okojima ‘604 to include a damper, damper means or damper assembly as recited in independent Claims 19, 37, 42, 58 and 83 to prevent the damage of a cosmetic or the movement of loose parts such as applicators.

Further, there is no objective evidence that it would have been obvious to one of ordinary skill in the art to modify the hinge structure of the vanity case of Okojima ‘604, “taught by Leung ‘085, motivated by the benefit of a slow, controlled, damped opening of the lid,” as the Office purports. Because the Office has failed to show any motivation or suggestion in Okojima ‘604 and Leung ‘085 to combine the references, the Applicants respectfully request that the Office provide some objective proof that it would have been obvious to one of ordinary skill in the art to modify the hinge structure of Okojima ‘604 with a damper means. See M.P.E.P. § 2143.01; in re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however, without a showing of a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

Furthermore, as stated on page 8 of the Office Action, Leung ‘085 “does not disclose pivoting the cover at a rate of about 60 to 120 degrees per second” as recited in Claims 19, 37, 47 and 63. Without a showing of a disclosure, motivation or suggestion in the art that

teaches the claimed “cosmetic container” or “container for holding a cosmetic” comprising, among other elements, a pivoting velocity, the Office has not established a *prima facie* case that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a specific angular velocity at which the case opens. To transform the “vanity case” of *Okojima ‘604* to the “container for holding a cosmetic” recited in independent Claims 19, 37, 42 and 58 or the “cosmetic container” recited in independent Claim 83 would require modifications taught only by the Applicants’ own disclosure.

Nonanalogous Art

Further, *Leung ‘085* is nonanalogous art. As M.P.E.P. § 2141.01(a) describes, “in order to rely on a reference as a basis for rejection,” the reference must either “be in the field of applicant’s endeavor, or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *See In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). There are many reasons why *Leung ‘085* is not considered to be in the field of the Applicants’ endeavor. For example:

- A cosmetic container is a relatively simple, non-electrical product whereas a calculator is a complex, electronic component including circuits, keys, and a display screen.
- The purpose of a cosmetic container is completely different from the purpose of a calculator. A cosmetic container is generally intended to contain or hold makeup, whereas a calculator is intended to assist a user in solving complicated mathematical problems and scientific equations.
- The manufacturers of cosmetic containers and calculators are in different channels of commerce because each product is unrelated to the other. Consequently, cosmetic containers and calculators are not in direct competition in the marketplace.
- Due to the extreme differences between calculators and cosmetic containers, (1) it is not economically feasible for manufacturers to invest in research and development of both products, and (2) manufacturers in each field do not look to art in the other field to develop new ideas and innovations. Accordingly, *Leung ‘085* is not in the field of the Applicants’ endeavor.

In addition, the calculator of Leung '085 is not reasonably pertinent to the problems addressed by the cosmetic container recited in Claims 19, 37, 42, 58 and 83. For example, Leung '085 teaches the use of a platform that “alternatively form[s] a cover for a display panel and a stand for the calculator.” See col. 2, lines 64-65 (FIG. 5). This problem is not pertinent to the problems addressed in the present Application. The present Application addresses the problem of providing a hands free cosmetic container where “activation of a user interface automatically positions the cover to a viewing position relative to the base of the container.” See paragraph [005]. Thus, the problem of Leung '085 teaches away from the cosmetic container recited in Claims 19, 37, 42, 58 and 83.

Leung '085 also does not appreciate the significant advantages of a cosmetic container having a lid that operates according to the claims. The Applicants' cosmetic container includes a cosmetic and/or an applicator that could potentially fall from the container if at an angle. The calculator of Leung '085 does not include loose parts under the cover of the calculator that are susceptible to falling out of the device when the cover is opened. Moreover, Leung '085 teaches away from this concept because any loose materials would fall out of the calculator of Leung '085 when opened because it would be at an angle relative to the horizontal. Conversely, Applicants' cosmetic container includes a cosmetic and/or an applicator that could potentially fall from the container if at an angle. Thus, unlike the calculator of Leung '085, the container for holding a cosmetic as recited in Claims 19, 37, 42, 58 and 83 provides a hands free opening device that minimizes the risk of components falling loose when opening the container.

Accordingly, the calculator of Leung '085 is not analogous to cosmetic containers, and Leung '085 may not be used alone, or in any proper combination with other references to show that the “container for holding a cosmetic” recited in Claims 19, 37, 42, 58, and 83 is obvious under 35 U.S.C. § 103(a).

Thus, the subject matter recited in Claims 19, 37, 42, 58, and 83 would not have been obvious over Leung '085 under 35 U.S.C. § 103(a). Claims 20-22, 38-41, 45-47, 53-54, 59-65 and 86 depend from Claims 19, 37, 42, 58 and 83.

Applicants' respectfully request withdrawal of the rejection of Claims 19-22, 37-41, 45-47, 53-54, 58-65 and 86 under 35 U.S.C. § 103(a).

Claims 23-31

In Section 9 of the Office Action, the Office rejected Claims 23-31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,799,604 to Okojima (Okojima '604) in view of U.S. Patent No. 6,178,085 to Leung (Leung '085) as applied to claim 22 above, and further in view of U.S. Patent No. 5,213,229 to Taniyama (Taniyama '229).

The Office acknowledged that “[Okojima '604] does not disclose a detent coupled to the cover or base to limit the range the cover pivots from the closed position to the open position.”

However, the Office stated that:

Taniyama '229 discloses a motion limiting mechanism for storage containers, comprising an arcuate slot (63') disposed on a container and a protrusion (62') disposed on a cover, for limiting the opening range of the cover. It is further disclosed, in col. 2, lines 17-20, that the arc of the arcuate slot may be enlarged or decreased, so as to vary the range of motion of the cover from within 0 to 360 degrees.

The Office concluded that “it would have been obvious to add an arcuate slot to the base component, and a limiting protrusion to the cover, as taught by [Taniyama '229], motivated by the benefit of customizing the opening angle of the cover.”

Claim 19 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly coupled to the hinge assembly and configured to limit pivoting of the cover at a rate of about 60 to 120 degrees per second.” Claims 21-31 depend from independent Claim 19.

Claim 19 is patentable for the reasons described above with respect to 35 U.S.C. §§ 102(b) and 103(a). Further, the “container for holding a cosmetic” recited in independent Claim 19 would not have been obvious in view of Okojima '604, alone or in any proper combination with Leung '085 and/or Taniyama '229 under 35 U.S.C. § 103(a). Okojima '604 alone or in any proper combination with Leung '085 and/or Taniyama '229 does not disclose, teach or suggest a “container for holding a cosmetic” comprising, in combination with other elements, “a damper assembly coupled to the hinge assembly and configured to limit pivoting of

the cover at a rate of about 60 to 120 degrees per second.” To transform the “vanity case” of Okojima ‘604 into a “container for holding a cosmetic” (as recited in Claim 19) would require still further modification, and such modification is taught only by the Applicants’ own disclosure.

The “container for holding a cosmetic” recited in Claim 19, considered as a whole, would not have been obvious in view of Okojima ‘604 in view of Leung ‘085 and/or Taniyama ‘229. Claim 19 is patentable over Okojima ‘604 in view of Leung ‘085 and/or Taniyama ‘229. Dependent Claims 23-31, which depend from independent Claim 19, are also patentable. See 35 U.S.C. §§ 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 23-31 under 35 U.S.C. § 103(a).

Claims 6-7 and 80-81

In Section 10 of the Office Action, the Office rejected Claims 6-7 and 80-81 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,799,604 to Okojima (“Okojima ‘604”) as applied above under 35 U.S.C. § 102(b) to claims 3 and 77, and in view of U.S. Patent No. 5,213,229 to Taniyama (“Taniyama ‘229”).

The Office acknowledged that “[Okojima ‘604] does not disclose a detent coupled to the cover or base to limit the range the cover pivots from the closed position to the open position.”

However, the Office stated that:

Taniyama ‘229 discloses a motion limiting mechanism for storage containers, comprising an arcuate slot (63') disposed on a container and a protrusion (62') disposed on a cover, for limiting the opening range of the cover. It is further disclosed, in col. 2, lines 17-20, that the arc of the arcuate slot may be enlarged or decreased, so as to vary the range of motion of the cover from within 0 to 360 degrees.

The Office concluded that “it would have been obvious to add an arcuate slot to the base component, and a limiting protrusion to the cover, as taught by Taniyama ‘229, motivated by the benefit of customizing the opening angle of the cover.”

Claim 1 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly coupled to the hinge assembly.” Claims 6-7 depend from independent Claim 1.

Claim 75 is in independent form and recites a “cosmetic container” comprising, in combination with other elements, a “hinge assembly comprising a spring and a damper.” Claims 80-81 depend from independent Claim 75.

Claims 1 and 75 are patentable for the reasons described above with respect to 35 U.S.C. §§ 102(b) and 103(a). Further, the “container for holding a cosmetic” recited in independent Claim 1 and the “cosmetic container” recited in independent Claim 75 would not have been obvious in view of Okojima ‘604, alone or in any proper combination with Taniyama ‘229 under 35 U.S.C. § 103(a). Okojima ‘604 alone or in any proper combination with Taniyama ‘229 does not disclose, teach or suggest a “container for holding a cosmetic” comprising, in combination with other elements, “a damper assembly coupled to the hinge assembly” (as recited in Claim 1) or a “cosmetic container” comprising, in combination with other elements, “a hinge assembly comprising a spring and a damper” (as recited in Claim 75). To transform the “vanity case” of Okojima ‘604 into a “container for holding a cosmetic” (as recited in Claim 19) or a “cosmetic container” (as recited in Claim 75) would require still further modification, and such modification is taught only by the Applicants’ own disclosure.

The “container for holding a cosmetic” recited in Claim 19 and the “cosmetic container” recited in Claim 75, considered as a whole, would not have been obvious in view of Okojima ‘604 in view of Taniyama ‘229. Claims 19 and 75 are patentable over Okojima ‘604 in view of Taniyama ‘229. Dependent Claims 6-7, which depend from independent Claim 1, and dependent Claims 80-81, which depend from independent Claim 75 are also patentable. See 35 U.S.C. §§ 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 6-7 and 80-81 under 35 U.S.C. § 103(a).

Claims 9-18

In Section 11 of the Office Action, the Office rejected Claims 9-18 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,799,604 to Okojima (“Okojima ‘604”) in view of U.S. Patent No. 5,213,229 to Taniyama (“Taniyama ‘229”) as applied to claim 6 above, and further in view of U.S. Patent No. 6,178,085 to Leung (“Leung ‘085”).

The Office acknowledged that “[Okojima ‘604] does not disclose a damping means limiting the pivot rate of the cover about the hinge.”

However, the Office stated that:

Leung ‘085 discloses a lid mechanism comprising a hinge, a coil spring (62) encapsulated in a cartridge (38), a plug (70), and a viscous damping grease (84). Frictional engagement between the plug and the cover allows the lid to be opened in a controlled, damped manner.

It is further disclosed, in col. 5, lines 49-53, that the damping mechanism serves to, “slow down and counteract any tendency for rapid pivoting movement of the lid structure which would cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof.” Although explicitly disclosed for preventing damage to electronics, one having ordinary skill would immediately recognize that the mechanism could be applied to any container wherein a rapid opening movement would be detrimental. In the immediate case, one having ordinary skill in the cosmetic compact arts would recognize a slow controlled movement would prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

The Office concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hinge structure of the vanity case of Okojima ‘604, providing the lid block (64) with a tubular portion/cartridge (38), coil spring (62), plug (70), and viscous damping grease (84) taught by Leung ‘085, motivated by the benefit of a slow, controlled, damped opening of the lid to prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

The Office also stated that “regarding claim 18, [Taniyama ‘229] discloses a detent and arcuate slot can be configured to allow a cover to pivot to any value between 0 and 360 degrees.”

The Office concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the arcuate slot of Okojima ‘604, as modified in view of Taniyama ‘229, to open the cover at least 60 degrees relative to the base, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claim 1 is in independent form and recites a “container for holding a cosmetic” comprising, in combination with other elements, a “damper assembly coupled to the hinge assembly.” Claims 9-18 depend from independent Claim 1.

Claim 1 is patentable for the reasons described above with respect to 35 U.S.C. §§ 102(b) and 103(a). Further, the “container for holding a cosmetic” recited in independent Claim 1 would not have been obvious in view of Okojima ‘604, alone or in any proper combination with Taniyama ‘229 and/or Leung ‘085 under 35 U.S.C. § 103(a). Okojima ‘604 alone or in any proper combination with Taniyama ‘229 and/or Leung ‘085 does not disclose, teach or suggest a “container for holding a cosmetic” comprising, in combination with other elements, “a damper assembly coupled to the hinge assembly.” To transform the “vanity case” of Okojima ‘604 into a “container for holding a cosmetic” (as recited in Claim 1) would require still further modification, and such modification is taught only by the Applicants’ own disclosure.

The “container for holding a cosmetic” recited in Claim 1, considered as a whole, would not have been obvious in view of Okojima ‘604 in view of Taniyama ‘229 and/or Leung ‘085. Claim 1 is patentable over Okojima ‘604 in view of Taniyama ‘229 and/or Leung ‘085. Dependent Claims 9-18, which depend from independent Claim 1, are also patentable. See 35 U.S.C. §§ 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 9-18 under 35 U.S.C. § 103(a).

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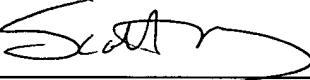
The Applicants respectfully submit that each and every outstanding objection and rejection has been overcome, and the present Application is in a condition for allowance. The Applicants request reconsideration and allowance of pending Claims 1-50, 52-54, 58-86 and 88.

The Office is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present Application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this Application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to the Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extension fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 4/27/04

By 

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